

## **REMARKS**

The Non-Final Rejection of August 27, 2007, and the Interview of November 6, 2007, have been carefully reviewed and this Amendment under 37 C.F.R. § 1.111 addresses the Examiner's concerns stated in the Non-Final Rejection and discussed in the Interview of November 6, 2007.

### **I. STATUS OF THE CLAIMS**

Claims 1, 3-30 are pending in the application.

Claims 1, 6, 11, and 22 have been amended to further define the invention. Support for the amendments can be found in Applicants' Specification, paragraphs 23 and 24. No new matter has been added.

Claims 5, 10, 15, and 24 have been amended for consistency with other amended claims. No new matter has been added.

Claim 27 has been amended to clarify terminology. No new matter has been added.

Claims 23 and 30 have been have amended to correct informalities. No new matter has been added

Claim 22 was objected to because of an informality.

Claims 6, 11, and 22 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 23 and 30 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 6, 8-9, 11, 13-15, 18, and 28 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ryan, Jr. et al., United States Patent # 7,071,437, issued on July 4, 2006, published on

July 3, 2003, filed on December 31, 2001 (Ryan). Applicants respectfully point out that Ryan was published within a year of Applicants' filing date, October 30, 2003. Applicants reserve the right to swear behind Ryan.

Claims 1, 3, 5, 7, 10, 12, 22-26, and 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Sansone, United States Patent Application # 2002/0141,613, published on October 3, 2002, filed on March 27, 2001 (Sansone).

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan as modified by Sansone, and in further view of Lopez, United States Patent Application # 2002/029,202, published on March 7, 2002, filed on December 13, 2000 (Lopez).

Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Bloomfield, United States Patent # 6,025,931, issued February 15, 2000 (Bloomfield).

Claims 19-21 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Sansone.

## II. INTERVIEW OF NOVEMBER 6, 2007

On November 6, 2007, Applicants' representative, Kathleen Chapman, and Examiner Bernard Krasnic discussed claims 1, 6, 11, 22, and 30, with respect to Ryan and Sansone. The Examiner and Applicants' representative discussed the meaning of the term profile. The Examiner suggested describing the term profile in the claims, as well as augmenting the independent claims with limitations of the dependent claims.

## III. CLAIM OBJECTION

On page 3, in paragraph 4, the Office Action has objected to claim 22 because of inconsistent wording. Claim 22 has been amended to make its wording consistent with other claims.

#### IV. REJECTIONS UNDER 35 U.S.C. § 101

On pages 4-5, in paragraph 5, claims 6, 11, and 22 were rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter. The Office Action states that Applicants' claimed computer readable memory and computer readable code can range from paper on which the program is written to a program simply contemplated and memorized by a person.

It is submitted that both terms "computer readable memory" and "computer readable code" are sufficiently well-known in the art to exclude the possibility that either are "programs simply contemplated" or "programs memorized by a person" because the qualifiers "computer readable" limit the terms to "memory" and "code" that can be read by a computer. Programs a person is contemplating or that a person has memorized do not fall under such a qualifier. Further, it is submitted that "computer readable memory" cannot be interpreted to include paper because computer memory has a specific meaning in the art that does not include paper.

Further, claims 6, 11, and 22 are in almost exactly the form of *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency). For example, similar to the *In re Lowry* claim, claim 6 refers to "at least one computer readable memory having a database storing data" (*In re Lowry* states "a memory for storing data" in the beginning of the preamble). The term "memory," in the computer arts, is a well-established term of art and the definition of the term "memory" can be found in, for example, Encyclopedia of Computer Science, Fourth edition (2003), pp. 1130-1144, and which starts by stating "different levels of memory (or storage) are usually employed in a computer system and one extreme are the very fast and are deeply small storage unit uses fast access registered by the central processing unit (CPU). At the other extreme are relatively slow, large capacity units of auxiliary storage. The auxiliary storage devices may be magnetic disk, tape, or optical disc."

Still further, it is submitted that claims 6, 11 and 22 are system claims and as such they are statutory. It is stated in the MPEP that computer programs are often recited as part of a claim.

USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory. (MPEP 2106.01)

Applicants have amended claims 11 and 22 to clarify that computer readable code is embodied in computer readable memory.

#### V. CLAIM REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

On pages 5-6, in paragraphs 6-7, claims 23 and 30 are rejected under 35 U.S.C. § 112, second paragraph, as lacking proper antecedent basis. Claims 23 and 30 have been amended to correct the antecedent basis. No new matter has been added.

#### VI. REJECTIONS UNDER 35 U.S.C. § 102

On pages 2-3 and 6-9, in paragraphs 2-3 and 8-9, the Office Action states that claims 6, 8-9, 11, 13-15, 18, and 28 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Ryan.

Applicants respectfully point out that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (CAFC, 1987), M.P.E.P. § 2131. As provided by the remarks set forth below, clearly this is not the case with the present rejection of the claims.

On page 2, in paragraph 3, the Office Action states that Applicants argued in the previous response that Ryan does not disclose having a plurality of predetermined profiles where each profile consists of a plurality of profile image characteristics. Applicants did not make that argument. Instead, Applicants submitted, and continue to submit, that, with respect to amended independent

claims 6 and 11, Ryan does not anticipate Applicants' claimed computer readable code configured to cause at least one processor to compare mail piece image characteristics to the selected predetermined profile from the retrieved data, and identify the mail piece as requiring one of the plurality of actions identified by the action identifier from the retrieved data, if the mail piece image characteristics present in the retrieved data substantially match the values for the selected predetermined profile from the retrieved data *because Ryan simply concludes that a mailpiece is suspect if the mailpiece meets a particular percentage of the criteria stored in the suspect database* (Ryan, col. 12, lines 22-24). In Ryan, apparently the mail piece is compared against the criteria on each pass, without an apparent sorting of criteria into subsets, whereas Applicants' claimed profiles include a plurality selected image characteristics.

It is also submitted that nowhere does Ryan state or suggest that the criteria are members of profiles, nor that they have values, nor that the profiles are each associated with a plurality of actions, as Applicants have claimed. Instead, Ryan simply states that "The suspect database contains various criteria such as the criteria described above (under the heading SUSPECT/HARMFUL MAILPIECES) for determining a suspect mailpiece." (Ryan, col. 12, lines 15-18).

It is further submitted that Ryan's "different actions" as stated in the Office Action in paragraph 3, on page 3, such as sanitization/processing area, video coding terminal, or audio recognition (see Office Action, page 3, paragraph 3, and Ryan, col. 12, lines 54, col. 13, lines 13-17 and 29-31), do not anticipate Applicants' claimed action identifier because Applicants claim an action identifier that identifies the mail piece as requiring one of a plurality of actions if the mail piece image characteristics present in the retrieved data substantially match one of the plurality of predetermined profiles from the retrieved data. Ryan does not disclose or suggest an action identifier, and, indeed, does not need one. The Applicants' claimed decision process i.e. "if the mail piece image characteristics present in the retrieved data substantially match one of the plurality of predetermined profiles", can be compared to Ryan's comparison at FIG. 9c, ref # S210. Applicants' action identifier identifies a mail piece as requiring one of a plurality of actions *after* the mail piece has been determined to be suspect, i.e. at Ryan, FIG. 9c, ref #s S211 and S212. In fact, neither of steps S211 or S212 either assigns an action identifier or makes use of an action identifier. In step S212, the mailpiece is diverted to collection module 25 by diverter 24. In an alternate embodiment, at

step S211, an identification (ID) code 32 is printed on the mailpiece and may be read in subsequent sorting passes. In the alternate embodiment, after step S211, the suspect mailpiece 30a is diverted to collection module 25 by diverter 24 (Ryan, col. 12, lines 58-65).

It is still further submitted that Ryan does not disclose Applicants' claimed profile identifier (amended independent claims 6 and 11) because Ryan does not group characteristics and their values in a way that would require Applicants' claimed profile identifier.

With respect to dependent claims 5, 10, 15, and 24, it is submitted that Ryan does not disclose Applicants' claimed selected combinations of profile image characteristics because Ryan's list of criteria is not selectively combined, but is a simple list.

It is submitted that dependent claims 8, 9, 13, 14, 18, and 28 are patentable at least by virtue of their selective direct or indirect dependence upon independent claims 6 and 11.

Since Ryan does not teach each and every element of Applicants' amended independent claims 6 and 11 and claims 8-9, 13-15, 18, and 28 which depend selectively therefrom, Applicants' amended independent claims 6 and 11 and dependent claims 8-9, 13-15, 18, and 28, are not anticipated by Ryan, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Further, it is submitted that amended independent claims 6 and 11 and dependent claims 8-9, 13-15, 18, and 28 are not made obvious by Ryan under 35 U.S.C. § 103. Applicants assert that amended independent claims 6 and 11 and dependent claims 8-9, 13-15, 18, and 28, are now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 102(e) with regards to amended independent claims 6 and 11 and dependent claims 8-9, 13-15, 18, and 28, for the reasons set forth above.

#### IV. REJECTIONS UNDER 35 U.S.C. § 103

On pages 9-16, in paragraphs 10-11, the Office Action states that claims 1, 3, 5, 7, 10, 12, 19-27, and 29-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Sansone.

In order for a rejection under 35 U.S.C. § 103 to be sustained, the Office Action must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants have amended independent claims 1 and 22 to further define the invention. Support for the amendments can be found in Applicants' Specification, paragraphs 23 and 24. No new matter has been added.

It is submitted that amended independent claims 1 and 22 are not made obvious by Ryan in view of Sansone because (1) Ryan does not disclose Applicants' claimed step of selecting a combination of values for individual profile image characteristics to create each one of the plurality of predetermined profiles, the values being chosen such that the combination is consistent with threat mail, the individual profile image characteristics being associated with various locations on the postage side of the mail piece, and (2) Sansone cannot make up this deficiency because neither does Sansone disclose Applicants' claimed step as above. With respect to (1), Ryan does not disclose values chosen such that the combination is consistent with threat mail, nor values associated with various locations on the postage side of the mail piece because Ryan's single characteristic with which comparisons are made (Applicants' step (e)) is addressee, found in a single general location on the mail piece. With respect to (2), Sansone cannot make up the deficiency in Ryan because, in Sansone's system, a large group of characteristics is compared against the mail piece in no particular order, and if two match, the mail piece is considered a threat (Sansone, paragraph 42), but nowhere does Sansone *select* a combination of values chosen such that the *combination* is consistent with threat mail, and where the characteristics are associated with various locations on the postage side of the mail piece.

On page 10, the Office Action states that Ryan "could check the sender's address or recipient's address first" and that there is a test in Ryan to compare "if the one of the plurality of predetermined profiles/senders or recipients address substantially matches the mail piece image

characteristics". It is submitted that nowhere does Ryan compare a sender address. Ryan's comparisons are limited to comparing the addressee on the mail piece to Ryan's addressee database. In Ryan, the sender address can be recorded for a suspect mail piece (Ryan, col. 13, lines 50-53), but the sender address is not used in any comparisons disclosed by Ryan.

Further neither Ryan nor Sansone disclose Applicants' claimed step of repeating steps d) through f) for another one of the plurality of predetermined profiles because (1) Ryan fails to specifically suggest Applicants' claimed step (Office Action, page 11), and (2) Sansone cannot make up the deficiency in Ryan because Sansone simply compares sender and recipient addresses separately, but not in the form of Applicants' claimed chosen combination that is consistent with threat mail.

It is submitted that amended dependent claim 3 is not obvious in view of Ryan and Sansone at least because of its dependence on allowable independent claim 1.

It is submitted that amended dependent claims 5, 10, and 24 are not obvious in view of Ryan and Sansone because neither Ryan nor Sansone discloses or suggests Applicants' claimed predetermined profiles that are combinations of values chosen such that the combination is consistent with threat mail. Any comparisons that are done in Ryan and Sansone are against individual characteristics in isolation, but not in combination with each other.

It is submitted that amended dependent claims 7, 12, and 23 are not made obvious by Ryan in view of Sansone because neither Ryan nor Sansone states Applicants' claimed plurality of actions identified by an action identifier. As stated previously, Ryan does not state or suggest that the criteria are stored as profiles, nor that the criteria are data such as an identifier or an action identifier. In fact Ryan teaches away from such an interpretation because Ryan lists criteria (Ryan, col. 5, lines 20-65), and the list does not include an identifier or an action identifier. Sansone cannot make up the deficiency in Ryan because not only does Sansone not state Applicants' claimed profiles that include data comprising an identifier, an image characteristic, and an action identifier, but Sansone states particular databases for particular characteristics such as threat characteristics, sender names, etc., and none of these databases is stated to contain anything but the particular characteristic. Thus Sansone neither states nor suggests Applicants' claimed database having an identifier or an action identifier where the database also includes image characteristics.



It is submitted that dependent claims 25, 26, and 29 are not obvious in view of Ryan and Sansone at least because of their dependence on allowable independent claims 1 and 22.

It is submitted that step (m) of dependent claim 30 is not made obvious by Ryan and Sansone for the same reasons stated with respect to amended independent claims 1 and 22. Therefore, Ryan and Sansone, either separately or in combination, do not state a *prima facie* case for obviousness because Ryan and Sansone do not teach or suggest all the claim limitations of amended dependent claim 30. In particular, neither Ryan nor Sansone nor their combination teach or suggest Applicants' claimed repeatedly retrieving other profiles if the predetermined profile does not match the mail piece image characteristics.

It is submitted that dependent claims 19-21 and 27 are not made obvious by Ryan and/or Sansone. With respect to Ryan, Ryan does not disclose or suggest a simultaneous comparison because Ryan provides no information whatsoever on how comparisons are made with Ryan's suspect database: "information read from the mailpiece is compared to information in suspect database 26. . . The system 153 also comprises software for performing the decision making process as to whether the mailpiece is suspect, such as is asked in the query of step S210. The software can be written such that when it is determined that a mailpiece meets a particular percentage of the criteria stored in suspect database 26 then the mailpiece is concluded to be suspect" (Ryan, col. 12, lines 13-24). Neither does Sansone disclose or suggest a simultaneous comparison because Ryan simply states a test that determines if any two threat indicators have matched with the data on the mail piece. An exemplary profile having selected image characteristics is shown in Applicants' Specification, paragraph 24, and includes, for example, initiating P&DC, destination address, destination-address style (e.g. handwritten), return-address style (e.g. not present), POSTNET bar code (e.g. not present), and envelope length (e.g. 7 inches). Applicants' system is clearly different from, more flexible than, and not obvious from Sansone because Applicants can establish any combination of image characteristics in a profile, whereas Sansone is limited to a specific sequence of comparisons against a specific set of characteristics. Therefore, Ryan and Sansone, either separately or in combination, do not state a *prima facie* case for obviousness because Ryan and Sansone do not teach or suggest all the claim limitations.

On pages 16-17, in paragraph 12, the Office Action states that dependent claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Lopez.

It is submitted that amended dependent claim 4 is not obvious in view of Ryan, Sansone, and Lopez for the same reasons stated with respect to amended independent claims 1 and 22, and amended dependent claim 30, namely because neither Ryan nor Lopez nor their combination discloses or suggests Applicants' claimed step of comparing a predetermined profile to mail piece image characteristics. As stated previously with respect to amended independent claims 1 and 22, Ryan and Sansone lack this step. Lopez does not make up the deficiency because Lopez performs certain steps on-line, and a different set of steps off-line, none of which steps include comparing mail piece characteristics against the predetermined profile.

On pages 17-18, in paragraph 13, the Office Action states that dependent claims 16 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Bloomfield.

It is submitted that dependent claims 16 and 17 are not obvious in view of Ryan and Bloomfield because neither Ryan nor Bloomfield nor their combination discloses or suggests Applicants' claimed remote server having computer readable code that identifies the mail piece as requiring one of the plurality of actions identified by the action identifier from the retrieved data. Ryan does not disclose Applicants' claimed remote server having computer readable code that includes an action identified by the action identifier from the retrieved data for the reasons stated previously with respect to dependent claims 7, 12, and 23. Bloomfield does not make up for Ryan's deficiency because Bloomfield simply forwards e-mail (Bloomfield, col. 7, lines 49-59) without reference to any sort of action identifier in a profile database.

Since none of Ryan, Sansone, Lopez, or Bloomfield, either individually or in combination, teach or suggest each and every element of Applicants' claims 1, 3-5, 7, 10, 12, 16-17, 19-27, and 29-30, Applicants' claims 1, 3-5, 7, 10, 12, 16-17, 19-27, and 29-30, are not made obvious by Ryan, Sansone, Lopez, and Bloomfield, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that claims 1, 3-5, 7, 10, 12, 16-17, 19-27, and 29-30, are now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to claims 1, 3-5, 7, 10, 12, 16-17, 19-27, and 29-30, for the reasons set forth above.

## VI. CONCLUSION

Amended independent claims 1, 6, 11, and 22 are believed to be in condition for allowance for the reasons provided herein. It is submitted that dependent claims 3-5, 7-10, 12-21, and 23-30 are also allowable for the reasons presented above, and further because they depend upon independent claims which are believed to be in condition for allowance, and are therefore also believed to be in condition for allowance.

Although no additional fees are anticipated, the Commissioner for Patents is authorized to charge additional fees, or credit overpayment, to Deposit Account No. 03-2410, Order No. 12078-194.

The following information is presented in the event that a call may be deemed desirable by the Examiner: Kathleen Chapman (617) 345-3210

Respectfully submitted,

Alfred T. Rundle et al., Applicants

Date: November 26, 2007

By: Kathleen Chapman/Rundle  
Kathleen Chapman  
Reg. No. 46,094  
Attorney for Applicants